

d) applying a second coating adjacent said first coating so as to use said edge to define at least one perimeter of said second coating; and

(e) applying a third coating on a second surface of said base;

wherein said substantial registration is present between said successive coatings along said edge as well as at regions of said successive coatings that are not immediate adjacent said edge.

#### REMARKS

Claims 1-55 were examined and claims 1-22 stand allowed. However claims 23-63 were finally rejected. More specifically, claims 23-27, 36-47, 51-55, and 60-63 were rejected as being anticipated by Yoshimura USP 5,560,796, and claims 28-31 and 36-63 were rejected as being anticipated by Hill USP 4,673,609. Further, claims 32-35 were rejected as being unpatentable over Yoshimura '796 in combination with Hill '609.

Applicant has amended claims 23, 28, 32, 36, 37, 51, 52, and 60. Claims 1-63 are pending, wherein claims 1-22 stand allowed.

#### A. CLAIMS 23-27, 36-47, 51-55, AND 60-63 ARE NOT ANTICIPATED BY YOSHIMURA

Claim 23 recites that "without cutting or punching" applicant forms an edge to define a perimeter for a first and second coating to achieve at least substantial registration that exists, among other locations, at coating regions that are "not immediately adjacent said edge".

With this clarification introduced into claim 23, applicant submits that the "cutting and punching" type registration asserted by the Examiner as occurring within Yoshimura and Hill is excluded from the present invention. As Yoshimura fails to disclose registration that exists other than right at the location of a cut or punched edge,

Yoshimura is overcome as a 35 USC §102 reference. Thus claim 23, and dependent claims 24-27 are patentable over Yoshimura.

Claim 36 (c) recites that “without cutting or punching” applicant’s edge on a second coating is defined, and that a substantially aligned relationship between first and second coatings is formed “on at least a part of said edge”. So amended, claim 36 overcomes Yoshimura, which as noted above, fails to disclose a substantially aligned relationship between coatings that exists other than right at the location of a cut or punched edge. Thus claim 36 and dependent claims 37-47 are patentable over Yoshimura.

Claim 51 explicitly recites that neither of applicants first or second base is a coating layer. So amended, claim 51 does not read on the structure of Yoshimura, and Yoshimura is overcome as a 35 USC §102 reference. Thus, claim 51 is patentable over Yoshimura, as are dependent claims 52-55.

Claim 60 modifies a base “without punching or cutting” to define an edge, and produces a material with a laminate pattern of coats that are in “substantial registration not merely at the edge, but also “at areas of said successive coatings that are not immediately adjacent said edge”. So amended, claim 60 overcomes Yoshimura, as do dependent claims 61-63.

#### B. CLAIMS 28-31 AND 36-63 ARE NOT ANTICIPATED BY HILL

Claim 28 is directed to forming a laminate pattern of coatings such that “substantial registration” is attained not only between successive coatings along at least one defined edge but also in “at least one area” of the coating not immediately an edge thereof.

At best Hill produces “exact registration” but only at an edge of a mechanically punched or drilled hole. Hill does not disclose every step of amended claim 28 and is overcome as a 35 USC §102 reference. Thus, claim 28 is patentable over Hill, as are dependent claims 29-31.

Claim 36 is directed to an article of manufacture whose second coating includes an edge that is defined “without cutting or punching”, and whose structure results in first and second coatings that are substantially aligned “on at least a part” of an edge. But at best Hill seeks registration by drilling or punching to remove a portion of an image, or by drilling, etc. such that layers of image design may be applied over the silhouette patterns. As such, Hill does not disclose every element recited in claim 36, and is overcome as a 35 USC §102 reference. Claims 37-50 depend from claim 36, and also overcome Hill.

Claim 51 is directed to an article of manufacture that includes a first base that is a non-coating layer, and a second base that is a non-coating layer. Hill does not disclose applicant’s first and second bases as defined by amended claim 51, and thus Hill is overcome as a 35 USC §102 reference. Claims 52-55 depend from claim 51 and are also not anticipated by Hill.

Claim 60 is directed to a method of forming a laminate pattern of coatings onto a material such that “substantial registration” exists not merely at an edge of a base, but also at areas of successive coatings that are “not immediately adjacent said edge”. Further, the base is modified to achieve this result, but is modified “without punching or cutting”. This method is not disclosed by Hill, whose methodology requires punching and cutting to achieve a form of registration that occurs only at the edge of a punched or cut opening. Thus claim 60 overcomes Hill as a 35 USC §102 reference, as do claims 61-63.

C. CLAIMS 32-35 ARE NOT RENDERED OBVIOUS BY YOSHIMURA AND/OR HILL

Claim 32 forms a pattern of coatings onto a patent with substantial registration that exists not only between coatings at at least an edge of the coatings. Further, the edge is formed "without cutting or punching". By contrast, Yoshimura and/or Hill rely upon "cutting" and "punching" to defining openings, where substantial registration occurs at best immediately only at the edge of such cut or punch openings.

As such, claim 32 is patentable over Yoshimura and/or Hill, as are dependent claims 33-35.

CONCLUSION

Claims 1-22 stand allowed. Claims 23-63 are patentable over the references of record. This Amendment should be entered, and claims 23-63 should be passed to allowance at this time.

A version of the text with markings to show additions and [deletions] effected by this amendment is attached hereto with the heading "Versions with Markings to Show Changes Made." Also attached hereto is a clean copy of the claims as pending after this amendment.

\* \* \* \*

The Commissioner is authorized to charge any additional fees that may be required, including extension fees, or credit any overpayment to Deposit Account No. 06-1300 (Our Order No. RI-69912/MAK).

Respectfully submitted,

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Filed under 37 C.F.R. § 1.34(a)

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claims 23, 28, 32, 36, 37, 51, 52 and 60 were amended as follows:

23. (amended) A method of forming a pattern of coatings onto a panel to achieve at least substantial registration between at least a part of successive coatings along at least one edge of said pattern, the method comprising the steps of:

- a) providing a base;
- b) applying a first coating to at least a part of said base;
- c) applying at least a second coating over at least a portion of said first coating;

and

d) without cutting or punching, forming an edge to define a perimeter for said first coating and said second coating to achieve at least substantial registration of said second coating with said first coating, said registration existing at areas of said first coating and said second coating including at least one region not immediately adjacent said edge.

28. (amended) A method of forming a laminate pattern of coatings onto a light permeable panel with substantial registration between [successive] at least two coatings along at least one defined edge of the pattern as well as at at least one area of said successive coatings not immediately adjacent said edge, the method comprising the steps of:

- a) providing a base material having a first side and a second side;
- b) cutting said base material to provide a desired pattern of perforate and non-perforate portions for attaining substantial registration of successively applied layers of coatings;
- c) applying a first coating to at least one non-perforate portion of said first side of said base material;
- d) applying at least a second coating over at least a portion of said first coating so as to define a laminate pattern of coatings with substantial registration along defined

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edges of at least a part of remaining non-perforate portions of cut said base material and with substantial registration along at least one area of said base material not immediately adjacent said edges; and

e) applying a light absorbing coating over at least a portion of said second side of said base;

wherein substantial registration exists between said first coating and said second coating including registration at at least one area of said coating not immediately adjacent an edge thereof.

32. (amended) A method of forming a pattern of coatings onto a panel with substantial registration between at least a part of successive coatings along at least one edge of the pattern and at at least one area of said successive coatings not immediately adjacent said edge, the method comprising the steps of:

- a) providing a base;
- b) without cutting or punching, forming an edge to define a perimeter for said coatings to achieve substantial registration;
- c) after forming said edge, applying a first coating to at least a part of said base; and
- d) applying at least one additional coating over at least a portion of said first coating;

wherein substantial registration exists between said coating and said additional coating at said edge.

36. (amended) An article of manufacture comprising:

- a) a base having at least a first surface and a second surface;
- b) a first coating on at least one surface of said base; and
- c) a second coating on a least a part of said first coating;  
said second coating having at least one edge that defines at least one perimeter on said base, said edge being defined without cutting or punching;

wherein said first coating and said second coating form a substantially aligned relationship with each other on at least a part of said edge.

37. (amended) An article of manufacture according to claim 36, wherein said base has at least one characteristic selected from a group consisting of (I) said base is formable, (ii) said base is deformable, (iii) said base is shape-changeable, (iv) said base is expandable, (v) said base is contractable, (vi) said base includes an area at least partially transmissive to light, (vi) said base is at least partially electrically conductive, (vii) said base is at least partially light transmissive, (ix) said base is at least partially light transmissive to visible light proximate a surface of said base, and (x) said base defines a hollow portion. [, .]

51. (amended) An article of manufacture, comprising:

a non-coating layer first base;

a non-coating layer second base;

means for attaching said second base to said first base;

at least one coating; and

at least one edge defining a perimeter.

52. (amended) An article of manufacture, according to claim 51, wherein at least a surface portion of said one coating defines [a second] an additional base.

60. (amended) A method of forming a laminate pattern of coatings onto a material with substantial registration between successive coatings along at least one defined edge as well as at areas of said successive coatings that are not immediately adjacent said edge, the method comprising the steps of:

- a) providing a base;
- b) modifying said base, without punching or cutting, on at least one base surface to define at least one edge;

- c) applying a first coating to said one surface of said base so as to use said edge to define at least one perimeter of said first coating;
- d) applying a second coating adjacent said first coating so as to use said edge to define at least one perimeter of said second coating; and
- (e) applying a third coating on a second surface of said base;  
wherein said substantial registration is present between said successive coatings along said edge as well as at regions of said successive coatings that are not immediate adjacent said edge.